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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,095	02/16/2001	Paul H. Feinberg	SONY 3.0-030	6178
530	7590	03/12/2004	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			YOUNG, JOHN L	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/785,095

Applicant(s)

FEINBERG, PAUL H.

Examiner

John L. Young

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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THIRD ACTION NONFINAL REJECTION

DRAWINGS

1. This application has been filed with drawings that are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful
process, machine, manufacture, or composition of matter or
any new and useful improvement thereof, may obtain a
patent therefore, subject to the conditions and requirements
of this title.

2. Claims 1-2, 9, 11-15, 17-20, 22-24, 26-31 are rejected under 35 U.S.C. 101, because said claims are directed to non-statutory subject matter.

As per claims 1-2, 9, 11-15, 17-20, 22-24, 26-31, as drafted said claims are not within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b) albeit limited by language to a useful, concrete and

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tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75, 47 USPQ 2d at 1602 (Fed Cir. 1998); *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999).

Note: it is well settled in the law that "[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims." (See MPEP 2173.05(q)).

Therefore, in this case, the claim language is merely non-functional descriptive material disembodied from the technological arts.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-48, are rejected under 35 U.S.C. §103(a) as being unpatentable over Treyz 6,587,835; class 705/14 (Jul. 1, 2003) [US f/d: Feb. 9, 2000] (herein referred to as "Treyz ").

As per claim 1, Treyz (col. 2, ll. 25-40) discloses: "*The location of the user may be determined by determining which local wireless transmitter/receiver the handheld*

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computer device is in communication with.” The location of the user may also be determined by using a GPS receiver associated with the handheld computing device. . . .”

Treyz (col. 23, ll. 35-55) discloses: *“If desired, the location of handheld computing device 12 and therefore the user may be determined using global positioning system (GPS) satellites. . . .”*

Treyz (FIG. 96) discloses: *“DETERMINE USER’S LOCATION IN STORE”*.

In this case, the Examiner interprets these disclosures as showing “receiving location information indicative of the geographical position of said client device. . . .”

Treyz (the ABSTRACT; FIG. 79; FIG. 81; FIG. 93; FIG. 99; FIG. 107; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 6; FIG. 7; FIG. 13; FIG. 14; FIG. 15; FIG. 19; FIG. 20; FIG. 21; FIG. 24; FIG. 25; FIG. 27; FIG. 35; FIG. 37; FIG. 39; FIG. 49; FIG. 59; FIG. 67; FIG. 66; FIG. 71; FIG. 73; FIG. 85; FIG. 96; FIG. 97; FIG. 98; col. 16, ll. 36-56; col. 21, ll. 1-25; col. 2, ll. 7-55; col. 11, ll. 48-56; col. 14, ll. 40-50; col. 26, ll. 65-67; col. 27, ll. 1-20; col. 53, ll. 27-37; col. 2, ll. 25-40; col. 23, ll. 35-55; col. 56, ll. 35-46; col. 53, ll. 60-67; and whole document) shows “A method of providing information to a client device, said method comprising automatically: receiving a request for information from said client device . . . selecting audio-visual content based on said request and regardless of said location information; selecting geographically-oriented information based on said location information; and sending response information to said client device, said response information comprising said geographically-oriented information and said content.”

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Treyz lacks explicit recitation of “receiving location information indicative of the geographical position of said client device. . .” even though Treyz (col. 2, ll. 25-40; col. 23, ll. 35-55; and FIG. 96) reasonably suggests same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that Treyz (col. 2, ll. 25-40; col. 23, ll. 35-55; and FIG. 96) would have been selected in accordance “receiving location information indicative of the geographical position of said client device. . . .” because selection of such features would have “[allowed] users with handheld computing devices to obtain information using local and remote wireless links. . . . [and] may also be used to order products and services.” (See Treyz (col. 1, ll. 40-45)).

As per claims 2-31, Treyz shows the method of claim 1 and subsequent base claims depending from 1.

Treyz (the ABSTRACT; FIG. 79; FIG. 81; FIG. 93; FIG. 99; FIG. 107; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 6; FIG. 7; FIG. 13; Fig. 14; FIG. 15; FIG. 19; FIG. 20; FIG. 21; FIG. 24; FIG. 25; FIG. 27; FIG. 35; FIG. 37; FIG. 39; FIG. 49; FIG. 59; FIG. 67; FIG. 66; FIG. 71; FIG. 73; FIG. 85; FIG. 96; FIG. 97; FIG. 98; col. 16, ll. 36-56; col. 21, ll. 1-25; col. 2, ll. 7-55; col. 11, ll. 48-56; col. 14, ll. 40-50; col. 26, ll. 65-67; col. 27, ll. 1-20; col. 53, ll. 27-37; col. 2, ll. 25-40; col. 23, ll. 35-55; col. 56, ll. 35-46; col. 53, ll. 60-67; and whole document) shows the elements and limitations of claims 2-31.

Treyz lacks explicit recitation of some of the elements of claims 2-31, even though Treyz reasonably suggests same.

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Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 2-31 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 2-31 .” because the concepts and the advantages of such features would have “[*allowed*] users with handheld computing devices to obtain information using local and remote wireless links. . . . [and] may also be used to order products and services.” (See Treyz (col. 1, ll. 40-45)).

As per claim 32, As per claim 1, Treyz (col. 2, ll. 25-40) discloses: “*The location of the user may be determined by determining which local wireless transmitter/receiver the handheld computer device is in communication with.*” *The location of the user may also be determined by using a GPS receiver associated with the handheld computing device. . . .*”

Treyz (col. 23, ll. 35-55) discloses: “*If desired, the location of handheld computing device 12 and therefore the user may be determined using global positioning system (GPS) satellites. . . .*”

Treyz (FIG. 96) discloses: “*DETERMINE USER’S LOCATION IN STORE*”. In this case, the Examiner interprets these disclosures as showing “receiving location information indicative of the geographical position of said client device. . . .”

Treyz (the ABSTRACT; FIG. 79; FIG. 81; FIG. 93; FIG. 99; FIG. 107; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 6; FIG. 7; FIG. 13; Fig. 14; FIG. 15; FIG. 19; FIG. 20; FIG.

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21; FIG. 24; FIG. 25; FIG. 27; FIG. 35; FIG. 37; FIG. 39; FIG. 49; FIG. 59; FIG. 67; FIG. 66; FIG. 71; FIG. 73; FIG. 85; FIG. 96; FIG. 97; FIG. 98; col. 16, ll. 36-56; col. 21, ll. 1-25; col. 2, ll. 7-55; col. 11, ll. 48-56; col. 14, ll. 40-50; col. 26, ll. 65-67; col. 27, ll. 1-20; col. 53, ll. 27-37; col. 2, ll. 25-40; col. 23, ll. 35-55; col. 56, ll. 35-46; col. 53, ll. 60-67; and whole document) shows “A portable system for presenting information to a user comprising: a processor; a positioning system; input means for receiving information from a user; a display; a modem; instructions executable by said processor, said instructions comprising receiving a request for information from a user via said input means; retrieving the geographic location of said positioning system from said positioning system; sending said request and said geographic location to a server via said modem; receiving from said server requested information and location information, said requested information being responsive to said request and said location information being responsive to said geographic location; and displaying said requested information and said location information.”

Treyz lacks explicit recitation of “retrieving the geographic location of said positioning system from said positioning system; sending said request and said geographic location to a server via said modem; receiving from said server requested information and location information. . . .” even though Treyz (col. 2, ll. 25-40; col. 23, ll. 35-55; and FIG. 96) reasonably suggests same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that Treyz (col. 2, ll. 25-40; col. 23, ll. 35-55; and FIG. 96) would have been selected in accordance “retrieving the geographic location of said positioning

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system from said positioning system; sending said request and said geographic location to a server via said modem; receiving from said server requested information and location information. . . .” because selection of such features would have “[*allowed*] users with handheld computing devices to obtain information using local and remote wireless links. . . . [and] may also be used to order products and services.” (See Treyz (col. 1, ll. 40-45)).

As per claims 33-40, Treyz shows the method of claim 32 and subsequent base claims depending from 32.

Treyz (the ABSTRACT; FIG. 79; FIG. 81; FIG. 93; FIG. 99; FIG. 107; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 6; FIG. 7; FIG. 13; Fig. 14; FIG. 15; FIG. 19; FIG. 20; FIG. 21; FIG. 24; FIG. 25; FIG. 27; FIG. 35; FIG. 37; FIG. 39; FIG. 49; FIG. 59; FIG. 67; FIG. 66; FIG. 71; FIG. 73; FIG. 85; FIG. 96; FIG. 97; FIG. 98; col. 16, ll. 36-56; col. 21, ll. 1-25; col. 2, ll. 7-55; col. 11, ll. 48-56; col. 14, ll. 40-50; col. 26, ll. 65-67; col. 27, ll. 1-20; col. 53, ll. 27-37; col. 2, ll. 25-40; col. 23, ll. 35-55; col. 56, ll. 35-46; col. 53, ll. 60-67; and whole document) shows the elements and limitations of claims 33-40.

Treyz lacks explicit recitation of some of the elements of claims 33-40, even though Treyz reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 33-40 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the

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art at the time of the invention to include the elements and limitations of claims 33-40 because the concepts and the advantages of such features would have “[*allowed*] users with handheld computing devices to obtain information using local and remote wireless links. . . . [and] may also be used to order products and services.” (See Treyz (col. 1, ll. 40-45)).

Independent claim 41 is rejected for substantially the same reasons as independent claim 32.

As per claims 42-48, Treyz shows the method of claim 41 and subsequent base claims depending from 41.

Treyz (the ABSTRACT; FIG. 79; FIG. 81; FIG. 93; FIG. 99; FIG. 107; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 6; FIG. 7; FIG. 13; Fig. 14; FIG. 15; FIG. 19; FIG. 20; FIG. 21; FIG. 24; FIG. 25; FIG. 27; FIG. 35; FIG. 37; FIG. 39; FIG. 49; FIG. 59; FIG. 67; FIG. 66; FIG. 71; FIG. 73; FIG. 85; FIG. 96; FIG. 97; FIG. 98; col. 16, ll. 36-56; col. 21, ll. 1-25; col. 2, ll. 7-55; col. 11, ll. 48-56; col. 14, ll. 40-50; col. 26, ll. 65-67; col. 27, ll. 1-20; col. 53, ll. 27-37; col. 2, ll. 25-40; col. 23, ll. 35-55; col. 56, ll. 35-46; col. 53, ll. 60-67; and whole document) shows the elements and limitations of claims 42-48.

Treyz lacks explicit recitation of some of the elements of claims 42-48, even though Treyz reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 42-48 were notoriously well known and expected in the art at

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the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 42-48 because the concepts and the advantages of such features would have “[*allowed*] *users with handheld computing devices to obtain information using local and remote wireless links. . . . [and] may also be used to order products and services.*” (See Treyz (col. 1, ll. 40-45)).

CONCLUSION

4. Any response to this action should be mailed to:

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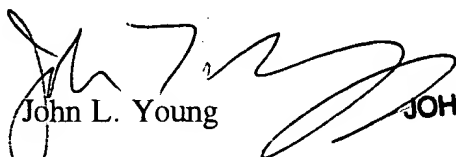
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


John L. Young
Primary Patent Examiner

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

March 8, 2004